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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,968

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EXAMINER

TRAN, MY CHAU T

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

06/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/803,968	ROH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MY-CHAU T. TRAN	2629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 and 8 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Application and Claims Status***

1. Applicant's response filed 05/09/2007 are acknowledged and entered.
2. Claims 1-8 were pending. No claims were amended, added and/or cancelled. Therefore, claims 1-8 are currently pending and are under consideration in this Office Action.

### ***Status of Claim(s) Objection(s) and /or Rejection(s)***

3. The rejection of claims 1-8 under 35 USC 102(e) as being anticipated by Wang et al. (US Patent Application Publication US 2004/0140962 A1; *filing date of 01/21/2003*) has been withdrawn in light of applicant's arguments (see pg. 3, fourth full paragraph, filed 05/09/2007) and Declaration Under 37 C.F.R. § 1.131.

### ***Response to Amendment***

4. The declaration filed on 05/09/2007 under 37 CFR 1.131 is sufficient to overcome the Wang et al. (US Patent Application Publication US 2004/0140962 A1; *filing date of 01/21/2003*) reference.

### ***Maintained Rejection(s)***

#### ***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Duret (US Patent Application Publication US 2002/0180714 A1).

For *claims 1, 3, and 7*, Duret disclose a pen (refers to instant claimed pen-shaped/handheld input system)(see e.g. Abstract; sections: [0002] and [0009]; fig. 2). As illustrated in figure 2, the pen comprises a magnetometer (ref. #8)(refers to instant claimed magnetic field detection unit) that is intended for measuring the magnetic fields, an inclinometer (ref. #10)(refers to instant claimed acceleration unit) that is an accelerometer, a processing electronic unit (ref. #14)(refers to instant claimed control unit) that is connected to an antenna (ref. #16)(refers to instant claimed communication module), which transmit the data from the processing electronic unit to a processing unit (ref. #2)(refers to instant claimed external computing device)(see e.g. sections: [0009], [0027], [0044]).

For *claim 2*, Duret disclose that the processing electronic unit calculate the position of the pen on the surface of the writing plane in terms of the measured magnetic fields values and the measured inclination angle  $\theta$  of the pen (see e.g. section [009] and [0032]-[0042]).

Therefore, the device of Duret does anticipate the instant claimed invention.

### ***Response to Arguments***

7. Applicant's arguments directed to the above 102(b) rejection were considered but they are not persuasive for the following reasons.

[1] Applicant contends that '*Duret fails to disclose or suggest an acceleration detection unit mounted in the pen-shaped body, for detecting respective axial direction accelerations of the movement of the pen-shaped body. Although Duret discloses the inclinometer 10 being an*

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*accelerometer, there is nothing to suggest that such an accelerometer would be able to detect respective axial direction accelerations of the movement of the pen-shaped body, as claimed’.*

This is not found persuasive for the following reasons:

[1] The examiner respectfully disagrees. It is the examiner’s position that Duret does disclose ‘*an acceleration detection unit mounted in the pen-shaped body, for detecting respective axial direction accelerations of the movement of the pen-shaped body*’. First, Duret disclose an inclinometer (ref. #10 of fig. 2)(refers to as the instant claimed ‘*an acceleration detection unit*’), which is depicted as being inside the pen (ref. #4 of fig. 2), (see section [0027], lines 3-5) and as a result the inclinometer of Duret meets all the structural feature of the instant claimed ‘*an acceleration detection unit*’, i.e. ‘*mounted in the pen-shaped body*’. Second, Duret does suggest the claimed functional limitation of the instant claimed ‘*an acceleration detection unit*’, i.e. ‘*for detecting respective axial direction accelerations of the movement of the pen-shaped body*’ (see section [0027], lines 3-5). Furthermore, in an apparatus claims the apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP § 2114, which states:

*APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART*  
>While features of an apparatus may be recited either structurally or functionally, claims< directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

*MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART*

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if

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the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Therefore, the teachings of Duret do anticipate the device of the instant claims, and the rejection is maintained.

### ***Allowable Subject Matter***

8. Claims 4-6 and 8 are allowable.

9. The following is a statement of reasons for the indication of allowable subject matter:

A. The instant claims 4 and 8 are allowed for the reason that the cited prior arts do not teach or fairly suggest the presently claimed method wherein the method comprises the step of '*detecting a tilt angle and three-dimensional axial direction an acceleration based on a movement of a handheld body at a magnetic field detection unit and an acceleration detection unit, respectively*'. Additionally, the declaration filed on 05/09/2007 under 37 CFR 1.131 is sufficient to overcome the Wang et al. (US Patent Application Publication US 2004/0140962 A1; *filing date of 01/21/2003*) reference.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T. TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MCT/  
May 17, 2007



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